



AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Assignee's Docket No.: 9137.00)
Group Art Unit: 3292)
Serial No.: 09/522,085)
Examiner: Frantzy Poinvil)
Filing Date: March 10, 2000)
Title: Self Service Terminal)

CERTIFICATE OF MAILING

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APPEAL BRIEF

**Part 1, on Pages 6 - 15, Serves as a Summary of Argument
And is Sufficient to Overcome the Rejections**

The fee for this Brief has been paid, at the time of filing a previous Brief, mailed on November 8, 2004.

1. REAL PARTY IN INTEREST

NCR Corporation.

2. RELATED APPEALS AND INTERFERENCES

None.

3. STATUS OF CLAIMS

Claims 1 - 8 and 22, 23, and 25 - 29 are pending, rejected,

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and appealed.

Claims 9 - 21, 24, 30, and 31 are cancelled.

4. STATUS OF AMENDMENTS

No Amendments-After-Final have been submitted.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Summary

Figure 2 of the Specification shows an Automated Teller Machine, ATM. Ordinarily, a user utilizes a keypad 28 and a display screen 26 to interact with the ATM to withdraw cash. See Specification, page 9, lines 4 - 7, and page 1, lines 8 - 11.

In one form of the invention, a modification is undertaken to the installed, functioning ATM. As described in the Specification, page 10, line 1 et seq., a transceiver 92 is added to the ATM, and new, or additional, software is installed. The transceiver 92 can take the form of an adapter card, which is installed in a vacant slot in the computer. (Specification, page 13, lines 9 - 12.)

With this modification, the ATM can respond to instructions issued from a wireless telephone. For example, a customer can use a wireless telephone to instruct the ATM to dispense cash. A wireless telephone provides advantages in security, and also its use may be preferred by some customers, as explained in the

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Specification, page 1, lines 17 - 24.

Mapping of Claim Elements to Specification and Figures

Parenthetical phrases, in **bold typeface**, are inserted into the following independent claims, to identify matter in the Specification and Figures which supports the claim language adjacent said **bold, parenthetical typeface**.

1. A method comprising:
 - a) in a group of ATMs (**page 8, line 25 - page 9, line 9**),
 - i) all of which are located in public places (**page 1, lines 17, 18**),
 - ii) all of which are connected to a financial network (**network 16 in Figure 1, page 8, lines 24, 25**);
 - iii) all of which are operable to dispense cash to customers in response to customer commands (**page 1, line 8; page 2, lines 5 - 12**);
 - iii) in which is contained a sub-group of ATMs in which the ATMs are not capable of dispensing cash in response to commands issued by a customer from a cellular

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telephone (page 7, lines 7 - 12; page 15,
lines 5 - 9; page 15, line 22 - page 16, line
4),

identifying an ATM in the sub-group (page 4, lines 12 -
16; page 5, lines 14 - 17); and

b) modifying said identified ATM into a retro-fitted
ATM which dispenses cash in response to commands
received from a cellular telephone (page 7, lines 10 -
12; page 4, lines 20, 21; page 13, lines 21 - 23; page
11, lines 11 - 15).

8. A method comprising:

identifying an ATM which has a screen for
displaying options for withdrawing cash and a touch
input mechanism for receiving user commands (page 5,
lines 15 - 17; page 2, lines 5 - 9); and

modifying said ATM into a retro-fitted ATM to
enable it to receive from a wireless telephone user
commands for dispensing cash without the use of said
touch input mechanism (page 4, lines 12 - 16; page 2,
lines 5 - 9; page 2, lines 22 - 25; page 6, lines 21 -
26; page 13, lines 3 - 5), wherein

1) the ATM, prior to modification, is
operative to (A) respond to user commands,

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including a command to dispense cash (page 1, lines 8 - 10;, and (B) cause a modification to the user's account (page 9, lines 20 - 23; page 20, lines 8 - 10; page 3, lines 1, 2; page 5, lines 11, 12),

2) the ATM, before and after modification, is connected to a host computer via a network (Figure 1, host 12, ATM 14a; page 4, lines 1 - 3),

3) before the modification, other ATMs are connected to the host computer via the network (page 4, lines 1 - 11; page 7, lines 7 - 12),

4) the other ATMs are operative to respond to user commands, including a command to dispense cash (page 2, lines 5 - 9),

5) all said ATMs are located in public places (page 1, lines 17, 18), and

6) at least some of the other ATMs are not modified to enable them to receive from a wireless telephone user commands for dispensing cash (page 7, lines 7 - 12; page 2, lines 6, 7 and 22, 23).

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6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejection of claims 1 - 8, 22, 23, and 25 - 29 as obvious under 35 USC 103, based on Suer and Norris or Suer and Gustin.

7. ARGUMENT

ARGUMENT RE: REJECTION OF CLAIMS 1 - 8, 22, 23, AND 25 - 29, BASED ON SUER, NORRIS, AND GUSTIN

This Argument is divided into three parts.

Part 1 shows that the 103 - rejection should be reversed.

Part 2 addresses contentions in the Final Rejection.

Part 3 addresses the Final Action's comments on arguments in Appellant's previous Amendment.

PART 1 - 103 REJECTION SHOULD BE REVERSED

Point 1A - Even if References are Combined, Claimed Invention is not Attained

Both independent claims (1 and 8) recite

-- an ATM which is **operative** to dispense cash, and

-- a modification of that ATM, which allows a user to order the ATM to dispense cash via a cellular telephone, or wireless telephone.

The Final Office Action relies on Suer to show this.

However, Suer shows an ATM at a factory, in the process of

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being manufactured. Suer, column 4, line 30 et seq., states that an IR (infra-red) receiver may be attached to the "terminal" (the ATM), to allow communication with a customer's PDA (Personal Digital Assistant). Suer calls this "wireless communication." (Column 4, line 32.)

Therefore, none of the following claim recitations are found in Suer:

- the initial **operative** ATM,
- the modification of that **operative** ATM,
- and
- the resulting operative ATM which dispenses cash in response to commands from a cell phone.

The Final Action, page 8, beginning at the sixth line from bottom, states:

The Examiner asserts that the device of Suer . . . is a wireless device and that wireless devices include PDA's and cell phones and wireless phones.

However, this assertion is reasoning backward.

If a claim recited a "wireless device," then Suer may show that. But the claims do not recite that. They recite a "cellular telephone" or a "wireless telephone."

Further, as explained later, at best, the Examiner is

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asserting that Suer's PDA and the claimed cell phone are both **species** in a common **genus** ("wireless devices"). That does not prohibit a patent on Appellant's **species**. Further, as explained later, special rules apply in this case, which have not been followed.

**Point 1B - Even if References are Combined,
Claimed Invention is not Attained**

As stated above, the claims recite a cell phone, or wireless telephone, which orders an ATM to dispense cash.

A cell phone/wireless phone, by definition, has the capability of making and receiving telephone calls.

Thus, the claimed device can

- make and receive telephone calls, and
- get cash from the claimed ATM.

That is not shown in Suer.

**Point 1C - Even if References are Combined,
Claimed Invention is not Attained**

The Final Action, page 6, bottom, asserts that it is obvious "to also include a wireless telephone device in the system of Suer . . ."

However, the Final Action has not explained what, exactly, the "wireless telephone device" does in Suer. Thus, even if that device is included, the claimed invention has not been shown.

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**Point 1D - Even if References are Combined,
Claimed Invention is not Attained**

Claim 2 recites installing a "program" in the ATM. No such "program" has been shown in the references.

Claim 3 recites retro-fitting the ATM with a "transceiver adapted to receive signals directly from the wireless telephone." No such "transceiver" has been shown in the references.

"SST" means Self Service Terminal. Claims 22 and 23 state that, prior to the claimed modification, an **operative** ATM/SST existed in a public place (which ATM/SST is modified as stated in a parent claim), which was not capable of receiving commands from a cell phone, or similar. That has not been shown in the references. A similar comment applies to claims 26 - 28.

Claim 25, and its parent, state that the "transceiver" (installed in the modification process) is assigned a telephone number, which the SST displays. That has not been shown in the references.

Claim 29 states that all communication between the wireless telephone and the ATM occurs "through the network." That has not been shown in the references, and is directly contrary to Suer's teaching of direct infra-red communication between his ATM and PDA, wherein no "network" is involved.

MPEP § 2143.03 states:

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To establish prima facie obviousness . . .
all the claim limitations must be taught or
suggested by the prior art.

Point 2 - Invention "As a Whole" is not Being Rejected

At least four differences exist between Suer and the claimed
invention.

One: no cell phone is shown in Suer.

Two: no operative ATM, in a public place,
which dispenses cash, is shown in Suer.

(Suer's ATM is on a factory floor, being
manufactured.)

Three: no modification, or retro-fitting, of
that **operative** ATM is shown in Suer.

Four: no resulting ATM which dispenses cash
in response to commands from a cell phone is
shown in Suer.

The rules require that the invention "as a whole" be shown
to be obvious. That is, as a minimum, all **four** of the
differences, **together**, must be shown to be obvious. Both section
103 and the MPEP require this.

Section 103 states:

A patent may not be obtained though the
invention is not identically disclosed or
described as set forth in section 102
if the differences between the subject matter
sought to be patented and the prior art are

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such that the **subject matter as a whole would have been obvious . . .**

MPEP § 2141.02 states:

In determining the differences between the prior art and the claims, the question under 35 USC 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

DISCLOSED INHERENT PROPERTIES ARE PART OF "AS A WHOLE" INQUIRY

In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question . . . but also those properties of the subject matter that are inherent in the subject matter and are disclosed in the specification.

. . . Just as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is the invention as a whole, and not some part of it, which must be obvious under section 103.

The Final Action has not complied with these rules.

Instead, the Final Action has only asserted that it is obvious to include a wireless telephone in Suer, and gives a supposed reason. (Final Action, page 6, bottom.)

But including a wireless telephone in Suer does not provide the claimed invention. The other three differences outlined above have not been shown.

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Then, the Final Action asserts that it is obvious to place Suer's ATM into a public place, and make it operative. A supposed reason is given. (Final Action, page 8, first paragraph.)

But that fails to show the other three differences.

The Final Action has failed to show that the two independent claims, **as a whole**, are obvious.

Instead, the Final Action has asserted that additions to Suer, which do not produce the entire invention, are "obvious."

Restated, the Final Action has asserted that a **subset** of claim 1, and of claim 8, are "obvious." But no rules exist defining "obviousness" of a **subset** of a claim.

Point 3 - No Expectation of Success Shown

No expectation of success has been shown, indicating that the combination of references actually works.

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . .

Second, there must be a reasonable expectation of success.

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. . . .

The . . . reasonable expectation of success must . . . be found in the prior art and not based on applicant's disclosure.

Suer, column 4, line 30 et seq., discusses installing an infra-red (IR) receiver in his ATM, during manufacture, to allow the ATM to communicate with a PDA, Personal Digital Assistant.

However, that IR receiver cannot communicate with the claimed cell phone. One reason is that cell phones use radio-frequency radiation (rf), to communicate with a cell tower (or satellite). In one form of the invention, the cell tower/satellite then communicates with a "single mode transceiver 92" which was installed in the ATM during the claimed retro-fit. (Specification, page 10, line 9.)

Since the cell tower/satellite cannot communicate with the IR receiver of Suer, no expectation of success has been shown.

From another point of view, an element in the combination of references is missing. That element is an adapter which connects to the ATM, which allows the ATM to communicate with a cell phone. No reference showing such an adapter has been applied.

Point 4 - Suer Teaches Away from Cell Phone Communication

Suer states that his PDA communicates **directly** with an ATM (or PC, or point-of-sale terminal).

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A cell phone, as in the claims, communicates with a third party (the cell provider), via a cell tower, or satellite. The third party then communicates with the ATM, via the telephone system, for example. (See Specification, page 10, lines 9 - 13.)

Suer is thus contradictory in his teaching as to the mode of communication: direct, or via third party.

Point 5

Appellant submits that the rejection is incorrectly classified as an obviousness rejection.

The Final Action, page 2, last paragraph, states that Suer shows a cell phone. And the Final Action relies on no other references to show the independent claims 1 and 8.

Consequently, the rejections of claims 1 and 8, and possibly others, are actually under section 102, on grounds of anticipation.

It is axiomatic that for Suer to **anticipate** claims 1 and 8, Suer must **infringe** them. (See PATENTS, A Treatise on the Law of Patentability, Validity, and Infringement, by D. Chisum, section 3.02[1], entitled, "The Classic Infringement Test.")

Plainly, Suer does not infringe.

Further, for a reference to be anticipatory under section 102, the reference must be **enabling**. (See Patents by D. Chisum, sections 3.06(1)(a) and 304(1).)

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As explained above, Suer is not enabling for the receipt of commands by an ATM from a cell phone. There is no receiver in Suer which can receive cell phone signals.

PART 2
RESPONSE TO FINAL REJECTIONS

Response 1

The Final Action, page 6 states:

Suer et al do not explicitly state the portable device is a wireless telephone.

The Examiner asserts that the device of Suer et al is a wireless device and that wireless devices include PDA's and cell phones and wireless phones.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to also include a wireless telephone device in the system of Suer et al in order to attract many types of users or customers having different types of portable devices.

Furthermore, it is noted that the type of wireless devices being used therein would not affect the system of Suer et al since such is merely used for the purpose of facilitating wireless communication with another terminal.

Point 1

SUMMARY

In brief: if a reference shows a **species**, that does not block a patent on another **species**.

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Restated: even if a generic classification ("wireless device," a **genus**) can be conjured up, which includes both Suer's PDA (a **species**) and the claimed cell phone (another **species**), that does not mean that Suer shows the claimed cell phone, nor that the claimed cell phone is not patentable.

Special rules apply in this case, which have not been followed.

DISCUSSION

The Final Action states:

The Examiner asserts that the device of Suer
. . . is a wireless device

and

that wireless devices include PDA's and cell
phones . . .

Thus, the PTO states that (1) "wireless device" is a genus,
(2) PDAs are a species, and (3) cell phones are a species.

MPEP § 2144 states:

. . .

The patentability of a claim to a specific
compound or subgenus embraced by a prior art
genus should be analyzed no differently than
any other claim for purposes of 35 U.S.C.
103.

"The section 103 requirement of
unobviousness is no different in chemical
cases than with respect to other categories

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of patentable inventions." [Citation.]

The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.");

This MPEP section further states that the PTO must

2. Ascertain the Differences Between the Prior Art Genus and the Claimed Species or Subgenus

Once a relevant prior art genus is identified, Office personnel should compare it to the claimed species or subgenus to determine the differences.

Through this comparison, the closest disclosed species or subgenus in the prior art reference should be identified and compared to that claimed.

Office personnel should make explicit findings on the similarities and differences between the closest prior art reference and the claimed species or subgenus including findings relating to similarity of structure, chemical properties and utilities.

. . .

4. Determine Whether One of Ordinary Skill in the Art Would Have Been Motivated To Select the Claimed Species or Subgenus

In light of the findings made relating to the three Graham factors, Office personnel should determine whether one of ordinary skill in the relevant art would have been motivated to

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make the claimed invention as a whole, i.e.,
to select the claimed species or subgenus
from the disclosed prior art genus.

Therefore, under this MPEP section, the mere fact that cell phones and PDAs are wireless devices is insufficient to reject the present claims. The PTO must provide a teaching as to why one would be motivated to replace the PDA in Suer by a cell phone.

Further, Appellant submits that section (2) of this MPEP section is not being followed. The Office Action asserts that cell phones are "wireless devices" and, based on that similarity with PDAs, are equivalent to PDAs.

However, that is contrary to section (2), which requires the PTO to analyze the "differences," meaning **ALL** "differences." Pointing to a **single SIMILARITY** fails to analyze any "differences" at all.

Further still, section (2) explicitly states:

Office personnel should make explicit
findings on the **similarities and differences**
between the closest prior art reference and
the claimed species or subgenus.

The Office Action has not done this.

Point 2

The conclusion of obviousness is a non sequitur. It does

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not follow from the assertion that both PDAs and cell phones are "wireless devices." As just explained, different **species** can be patentable (and thus not "obvious"), even if classified in a common **genus**.

Further, the following items can also be classified as "wireless devices:"

- A TV remote control,
- A remote car starter,
- A garage door opener, and
- A model airplane remote control.

Numerous others can be added.

The Final Action clearly relies on this classification (as "wireless devices") as a justification for adding a cell phone to Suer. But, as just explained, numerous other types of "wireless devices" also exist.

The Final Action must provide an explanation as to why a cell phone was chosen from all possible "wireless devices," and not another "wireless device."

No explanation has been given.

Point 3

The Final Action asserts that it is obvious to add a cell phone to Suer. However, no actual reason for doing so is given.

What is given is a **statement of what the cell phone**

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supposedly accomplishes (attracts many types of users etc.) But that is not a teaching for adding the cell phone in the first place. That is merely a **description of properties of** the combination of references.

Further, this goal (of attracting many types of users) has not been shown in the prior art. MPEP § 706.02(j), as explained herein, requires the teaching to be shown in the prior art.

Point 4

The final sentence ("Furthermore, it is noted . . . another terminal.") of this passage of the Final Action is incorrect.

Addition of a cell phone to Suer, without adding anything analogous to the "single mode transceiver 92," described in Appellant's Specification, page 10, line 9, renders the added cell phone **inoperative** (as to the ATM).

Thus, if a cell phone is to be added, then Suer must be **modified**. The final sentence is incorrect.

From another perspective, is Suer is **not modified**, then the cell phone is inoperative, and no expectation of success is shown.

Response 2

The Final Action, page 7, refers to characteristics of ATMs recited in the claims, and dismisses them, on the grounds that

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the characteristics are found in standard ATMs.

However, those characteristics are not found in Suer, so they are not found in the applied art. And the PDA etc. of Suer is not found in the standard ATMs, so the standard ATMs do not respond to PDAs, nor to the Final Action's extension to responding to cell phones.

From another perspective, the Final Action is merely asserting that the claim recitations in question are found in the prior art. That is not a basis for an obviousness rejection.

The PTO must show (1) the differences between the claims and the reference being modified and (2) provide a teaching for making the modification. That has not been done.

This applies to the Final Action, first paragraph on page 8, spanning from "Furthermore, whether or not . . ." to ". . . and after the modification."

Response 3

Point 1

The Final Action, page 8, first full sentence, asserts that "wherein" clauses can be ignored. Appellant points out that claim 1 does not contain the word "wherein."

Appellant points out that "wherein" means "in which." Such a clause sets forth characteristics of claim elements.

Also, this sentence states that the "wherein clause" "is a

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recitation that is neither 'steps or functions or structures' to be performed any functions." This part of the sentence makes no sense. Consequently, no response is required, nor can one be framed.

Point 2

The Final Action, page 8, second full sentence, asserts that the claims contain "intended use or descriptive language" which the Final Action can ignore. However, the Final Action has not identified the language in question.

Further, claim 1 **specifically states** the uses to which the ATM is **currently being put**: the ATMs are located in public places, connected to a network, etc. Those cannot be "intended" uses, because they currently exist in the claimed ATMs.

Still further, there is nothing wrong with "descriptive language." Section 112 requires that the claims "define" the invention. How does one "define" something, without "describing" it ?

Further still, it appears that the Office Action is asserting that claim 8 is a method claim containing structural limitations, which can be ignored.

MPEP § 608.01(n) states:

The fact that the independent and dependant claims are in different statutory classes

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does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependant claim.

(MPEP 608.01(n), last paragraph.)

Since the clauses of claim 8 in question could be written in dependent form, and be acceptable under this MPEP section, it makes no difference that they are included in the (parent) claim itself.

Response 4

Point 1

The Final Action, page 8, second full paragraph ("It would have been obvious . . ."), asserts that some of the claim recitations are "obvious," such as placing Suer's ATM in a network.

Appellant points out that this paragraph suffers two fatal defects.

One is that the reason given for the obviousness is to save customers from dealing with a human teller. However, that goal is attained by **merely installing** a machine which Suer manufactures, without any of the modifications proposed by the PTO. That is, no cell phone is necessary in Suer to obtain that goal.

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Therefore, the reason given does not lead to the claimed invention.

A second defect is that, again, the invention is not being evaluated **as a whole**. The Final Action is merely asserting that the addition of a couple of claim elements to Suer is "obvious." But those claim elements do not provide the entire invention (where is the cell phone ?).

Only "inventions" can be "obvious." Addition of parts of a claim to a reference, when the addition does not produce the entire invention, cannot be "obvious." There is no definition of "obvious" to apply. Only complete inventions can be "obvious."

Point 2

Appellant points out that the rejection is fatally flawed, because of the type of rejection just described, which is applied **twice**.

The Final Action, page 8, second full paragraph (discussed immediately above), adds some components to Suer, for a stated reason. But those added components do not produce the complete invention of the independent claims 1 or 8.

The Final Action, page 6, bottom, asserts that it is obvious to add a **different component** (a wireless telephone) to Suer, for a **different** stated reason. Again, a wireless telephone does not produce the complete invention of the independent claims 1 or 8.

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Stated more simply, the Final Action asserts

Case 1: Suer plus A and B is obvious,

Case 2: Suer plus C is obvious.

But Case 1 does not show either claim 1 nor 8, **as a whole**.

Nor does Case 2 show either claim 1 nor 8, **as a whole**.

The invention **as a whole** must be shown to be obvious. That has not been done.

There is no definition of "obvious" to apply to Case 1, or Case 2, because neither Case shows a claimed invention. Only inventions can be "obvious."

**PART 3
RESPONSE TO FINAL OFFICE ACTION'S
COMMENTS ON APPELLANT'S PREVIOUS AMENDMENT**

Preliminary Point - Disjunctive Fallacy

The Final Action repeatedly

- 1) finds an element in a reference, call it Element A, then
- 2) forms a disjunction between that element and an element supposedly in the claim, such as "Element A **OR** a cellular telephone," and then
- 3) makes a statement of the following type:
"The reference shows Element A or a cellular telephone."

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Although the statement in item (3) is technically correct, it is misleading.

The reason is that you can make a disjunction using **any true statement**, and the disjunction is true. For example, suppose that I have five dollars in my pocket. Then the following statement is true:

I have five dollars in my pocket
or
Elephants swim on the Moon.

This is technically a true statement. But the statement is only true because of its first part (the five-dollar-part).

Further, the statement will always be true, even if the other part is false.

This type of reasoning will be called the Disjunctive Fallacy. It is misleading, and can lead to erroneous conclusions.

Point 1

The Final Action, page 2, states:

Applicant's representative argues that the PDA of Suer is not a cell phone, and that PDAs with cell phone functions did not exist prior to the applicant's invention.

The Final Action then quotes Suer, column 4, lines 29-59.

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The Final Action then states:

From this teaching, it is clearly seen that the PDA of Suer functions as a cellular phone or include means of a cellular phone such as an IR or transmitter/receiver for transmitting/receiving data to/from an ATM device as for performing banking related functions. Thus, applicant's argument that the ATMs of Suer do not dispense cash in response to commands received from a cellular phone is not convincing.

Rebuttal 1

The Final Action merely asserts that Suer shows **part of** a cellular telephone. That fails to show the claimed invention, which recites a cellular telephone, or similar.

Further, the Final Action is invoking the Disjunctive Fallacy. The statement ". . . the PDA of Suer functions as a cellular phone or include means of a cellular phone such as an IR or transmitter/receiver . . ." Is only true because of the IR part.

In fact, Suer's PDA **DOES NOT** function as a cellular telephone. Further, cellular telephones do not utilize IR transmitters/receivers for the telephone function.

Rebuttal 2

Suer, column 7, line 37 et seq., gives detailed description of his PDA. It includes a writing surface 55 in which checks, or

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other documents, are written, and his device captures the writing electronically.

Cellular telephones do not do that, and if a cellular telephone replaces Suer's device, then Suer is rendered inoperative.

MPEP § 2143.01, section 5, states:

The proposed modification cannot render the prior art unsatisfactory for its intended purpose.

Point 2

The Final Action, page 3, states:

Applicant's representative then states that the PDA of Suer is not a TREO which is not qualified as prior art.

In response, a TREO is not being claimed or applied in the rejection. Therefore, the applicant's argument is persuasive. Moreover, the PDA of Suer includes all the means of a cellular phone for communicating with an ATM or other Point of sales devices.

Appellant points out that the Final Action misses the point. Appellant explained that modern PDAs, such as the TREO, may act as cell phones, as well as PDAs. However, such devices are not available as prior art.

The PTO must thus rely on an attachment to a PDA to attain the cell phone function. However, this attachment is nothing

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more than a cell phone, which is attached to the PDA, to allow activities such as Internet surfing, using the PDA's display. (See Appellant's previous Amendment, mailed April 30, 2007.)

Thus, in order to attain the functionality of a cell phone in Suer, you must add a cell phone. Suer's PDA does not act as a cell phone.

Point 3

The Final Action, page 3, states:

Applicant's representative then argues that if a cellular phone is introduced in the system of Suer, the claimed invention will be unattainable.

In response, the PDAs of Suer includes an IR and wireless means for communicating with an ATM or point of sale device. Introducing a cellular phone in the PDA of Suer would have been obvious to one of ordinary skill in the art at the time the invention was made since all the components are already present in the PDA of Suer.

Appellant points out that the response of the PTO does not rebut Appellant's argument.

Appellant points out that a cell phone in Suer cannot perform the functions which Suer executes, such as capturing handwriting (column 8, line 15) and communicating with an ATM using IR (column 4, line 30 et seq.) The PTO's response does not rebut this fact.

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Further, the response's invocation of "obviousness" is invalid. As explained above, only inventions can be obvious. The claimed invention differs from Suer in at least four aspects. The PTO's response asserts that one of those aspects (the cell phone) is "obvious" to add to Suer.

But addition of that aspect does not produce the claimed invention.

Therefore, the assertion of obviousness must be ignored, because it is unsupported in law.

Point 4

The Final Action, page 3, states:

Applicant's representative then argues that the Examiner stated that it would have been obvious to one of ordinary skill in the art to add a cell phone in the system of Suer without any rationale for so doing.

In response, the PDA of Suer communicates with an ATM with similar wireless means of a cellular phone. It is noted that the main components of a cell phone include an IR or wireless transmitter/receiver for communicating with an ATM already exist in the PDA of Suer. Introducing a cellular phone therein would have been obvious to one of ordinary skill in the art to do at the time of the invention in order to provide telephonic options to the user of the PDA.

Appellant points out that the response still does not

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provide a rationale for adding a cell phone to Suer.

In addition, the response invokes the Disjunctive Fallacy. It asserts that a "cell phone includes an IR or wireless transmitter/receiver" and that those already exist in the PDA of Suer. But a cell phone does not include an IR transmitter/receiver.

Further, the "wireless transmitter/receiver" which a cell phone contains is not found in Suer. That "wireless transmitter/receiver" must communicate with a cell tower (or satellite). That has not been shown in Suer.

Point 5

The Final Action, page 4, states:

Applicant's representative then argues that the PTO's motivation using wireless commands from a portable device to an ATM is the same as applicant's motivation and concludes that such is improper.

In response, most PDAs are used by users to privately do so at their privacy or convenience. The motivation the Examiner has applied, flows naturally in the normal uses of a wireless phone or PDA as such the Examiner did not glance at the applicant's specification to provide such a motivation.

Appellant points out that the Final Action incorrectly characterizes Appellant's argument. Appellant stated:

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One rationale given by the PTO for combining a cell phone with Suer's ATM is "to attract many types of users or customers having different types of portable devices." (Office Action, page 3, end of first paragraph.)

However, Applicant's Specification states that one goal of Applicant's invention is to allow different users, each with a cell phone familiar to the user, to use unfamiliar ATMs.

See the third paragraph of Background of the Invention, which states:

There are a number of different ATM manufacturers, and each manufacturer produces a different style of ATM. In addition, each manufacturer generally has a range of ATM styles, depending on the level of functionality provided by the ATM. This gives rise to a plethora of different types of user interfaces. Users of an ATM may have to spend time familiarizing themselves with the layout of the ATM before they feel confident enough to use the ATM.

See also the third paragraph of Summary of Invention, which states:

By virtue of this aspect of the invention, an ATM may be modified so that a user can withdraw cash using a wireless telephone, such as a cellular telephone. Thus, a user is able to use the user interface associated with his/her telephone rather than the user interface provided by the ATM. This enables a user to use the same user interface (that of his/her telephone) regardless of the make or style of ATM that they are using. By allowing a user to use his/her wireless telephone, privacy is improved because a third party will have more difficulty in viewing information presented on the telephone's display than on the ATM's

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display. Furthermore, environmental issues can be greatly obviated by allowing a user to bypass, in whole or in part, the existing touch input mechanism.

Therefore, Applicants submit that the rationale used by the PTO is the same as, or similar to, the rationale given in Applicants' Specification.

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

. . . .

The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art and not based on applicant's disclosure.

Applicants submit that the PTO is using Applicant's own Specification as a teaching, which is forbidden by this MPEP section. This conclusion is supported by the fact that the PTO has not shown an independent source of its rationale.

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In addition, Appellant points out that the MPEP requires the Examiner to read Appellant's Specification. (See MPEP § 702. MPEP § 704.01 states: "**After reading the specification** and claims, the examiner searches the prior art.")

Thus, a presumption arises that the Examiner read the Specification.

Appellant submits that the present self-serving assertion that the Examiner "did not glance at the applicant's specification" does not rebut the presumption.

From another point of view, Appellant submits that the Examiner is now estopped from making this assertion, for at least the following reason. By proceeding with handling this application, the Examiner has tacitly admitted that he is following the prescribed procedures. That includes an admission that he has read the Specification, as required by the MPEP.

Point 6

The Final Action, page 4, states:

Applicant's representative then states that the mere fact that cell phones and PDAs share a common feature is not a reason for concluding that it is obvious to replace a PDA by a cell phone.

In response, PDAs and cell phone have and share common characteristics and also uncommon characteristics. In relation to the

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claimed invention, the PDA of Suer and a cell phone would serve the same purpose, which is communicating with an ATM.

Introducing features of a cellular phone in the PDA of Suer has been discussed above

..

Appellant points out that the claimed cell phone cannot communicate with Suer's "IR adapter." (Column 4, line 34.) Thus, an element is missing from the combined references, namely, that adapter.

In addition, the Final Action, in essence, is asserting that the claimed cell phone and Suer's PDA share common characteristics, namely, the ability to communicate with an ATM. However, this assertion suffers two fatal defects.

One is that, as just explained, the assertion is false. A cell phone cannot communicate with an ATM, unless the ATM is equipped with a device which allows that. Suer shows no such device.

The fact that Suer's IR adapter may be generically classified as a "wireless transceiver" does not change this fact. Changing the name given to the IR adapter does change the physical properties of the adapter. It still cannot communicate with a cell phone.

The second defect is that, even if the Final Action's assertion be correct, that is irrelevant.

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The reason is that the assertion **ignores the claim language**. The claims recite a "cell phone" or similar, which causes an ATM to dispense cash. But the "cell phone" can make, and receive, telephone calls. That is not found in Suer.

Point 7

The Final Action, page 4, states:

Applicant's representative then argues that the Examiner's statement of the modified ATMs "still ... perform in the same manner before and after modification" is incorrect and self-contradictory.

In response, applicant's comment is not persuasive. It is noted that only an additional feature of a cellular phone is added to the PDA of Suer. The ATMs whether modified or not with the addition of a transceiver to receive data from a cell phone would not operate in a manner different before modification as the operation of the ATMs remain the same which is to perform banking functions. The only modification is the addition of a cell phone to the PDA.

Appellant points out that, if an ATM is modified to allow it to communicate with a cell phone, then it **DOES NOT** "perform in the same manner" as before the modification.

Appellant points out that the Final Action is self-contradictory. Here it asserts that a cell phone is added to Suer.

Previously, it asserted that the PDA of Suer qualifies as

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the claimed cell phone.

Point 8

The Final Action, page 5, states:

Applicant's representative then argues that the Office action is not evaluating the invention as a whole and does not consider the recitation of the functioning ATM being in a public place is retrofitted with a cell phone.

In response, the Examiner disagrees. Most ATMs are usually placed in public places having high customer traffic. The ATMs in the system of Suer are retrofitted to include an IR and transmitter/receiver to communicate with the PDA.

Appellant points out that the ATM of Suer is not in a public place, but on a factory floor.

The ATMs in Suer are not "retrofitted" as claimed.

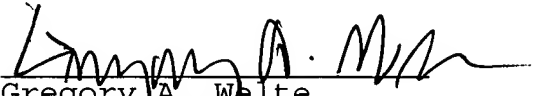
- They are not operational ATMs.
- They are not given the ability to receive commands from cell phones.

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CONCLUSION

Appellant requests that the Board overturn the rejections,
and pass all claims to issue.

Respectfully submitted,


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ATTACHMENTS: CLAIMS APPENDIX, and statements that no EVIDENCE
APPENDIX nor RELATED APPEALS APPENDIX are submitted

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1. A method comprising:

a) in a group of ATMs,

i) all of which are located in public places,

ii) all of which are connected to a financial network;

iii) all of which are operable to dispense cash to customers in response to customer commands;

iii) in which is contained a sub-group of ATMs in which the ATMs are not capable of dispensing cash in response to commands issued by a customer from a cellular telephone,

identifying an ATM in the sub-group; and

b) modifying said identified ATM into a retro-fitted ATM which dispenses cash in response to commands received from a cellular telephone.

2. The method of claim 1 wherein said modifying step includes retrofitting said ATM with a program for enabling said ATM to receive a transaction from a remote source.

3. The method of claim 1 wherein said modifying step includes retrofitting said ATM with a transceiver adapted to receive signals directly from the wireless telephone.

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4. The method of claim 3, wherein said transceiver is further adapted to transmit signals directly to said wireless telephone.

5. The method of claim 4 wherein said signals implement local wireless communication.

6. The method of claim 1 wherein said ATM is connected to a network for communication therebetween, and wherein said modifying step includes providing a connection between said network and said wireless telephone.

7. The method of claim 1 wherein said modifying step includes: retrofitting said ATM with a transceiver adapted to receive signals directly from a wireless telephone; and providing a connection between said network and said wireless telephone.

8. A method comprising: identifying an ATM which has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands; and modifying said ATM into a retro-fitted ATM to enable it to receive from a wireless telephone user commands for dispensing cash without the use of said touch input mechanism, wherein

- 1) the ATM, prior to modification, is operative to (A) respond to user commands,

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including a command to dispense cash, and (B) cause a modification to the user's account,

- 2) the ATM, before and after modification, is connected to a host computer via a network,
- 3) before the modification, other ATMs are connected to the host computer via the network,
- 4) the other ATMs are operative to respond to user commands, including a command to dispense cash,
- 5) all said ATMs are located in public places, and
- 6) at least some of the other ATMs are not modified to enable them to receive from a wireless telephone user commands for dispensing cash.

22. Method according to claim 1, wherein, prior to the process of modifying said ATM, said ATM was incapable of receiving user commands for dispensing cash from a wireless telephone.

23. Method according to claim 20, wherein, prior to modifying, no ATMs could receive user commands for dispensing

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cash from a wireless telephone.

25. Apparatus according to claim 23, wherein the transceiver is assigned a telephone number, and the SST displays that telephone number to customers.

26. Method according to claim 15, wherein the SST was unable to receive user commands from a wireless telephone prior to the modifying process.

27. Method according to claim 7, wherein said ATM was unable to receive signals directly from a wireless telephone prior to the modifying step.

28. Method according to claim 8, wherein said ATM was unable to receive signals directly from a wireless telephone prior to the modifying step.

29. Method according to claim 6, wherein communication between the wireless telephone and the ATM occurs through the network.

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9. EVIDENCE APPENDIX - None

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10. RELATED PROCEEDINGS APPENDIX - None